



PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicants | : François GIRARD et al. |) | |
| Appln. No. | : 10/570,347 |) | Group Art Unit 3618 |
| Docket No. | : P29468 |) | Examiner Katy E. MEYER |
| Customer No. | : 07055 |) | Confirmation No. 5450 |
| I.A. Filed | : September 1, 2004 |) | |
| Title | : CROSS-COUNTRY SKI SYSTEM PROVIDED WITH A DIRECT BEARING LATERAL SURFACE |) | |

ARGUMENTS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

U.S. Patent and Trademark Office
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401 Dulany Street
Alexandria, VA 22314

Sir:

Pursuant to the Official Gazette Notice published on July 12, 20005, entitled "New Pre-Appeal Brief Conference Pilot Program," Applicants herewith present arguments which accompany a completed and signed form PTO/SB/33, entitled "Pre-Appeal Brief Request for Review."

Being filed concurrently herewith are a Notice of Appeal pursuant to 37 CFR §41.31, a request for extension of time for one month, and instruction to charge to Deposit Account payment in the amount of \$670.00 for the appeal fee pursuant to 37 CFR §41.20 and the extension fee pursuant to 37 CFR §1.17(a).

ARGUMENTS

Applicants kindly request that the three grounds of rejection be withdrawn: the rejection of claims 8-15 and 17-39 under 35 USC §103(a) over GIGNOUX et al. (U.S. Patent No. 6,390,494, "GIGNOUX") in view of BEJEAN et al. (U.S. Patent No. 5,011,179, "BEJEAN"); the rejection of claim 16 under 35 USC §103(a) over BEJEAN in view of GIGNOUX and KENNEY (U.S. Patent No. 6,257,620); and the rejection of claims 29, 32, 34, 37, and 39 under 35 USC §112, first paragraph, as failing to comply with the written description requirement.

A. Summary of the Invention

The invention is directed to a ski and for ski “system” (i.e., ski with binding), particularly of the Nordic or cross-country type, in which the skier’s boot is attached to the ski while allowing the skier’s heel free to alternately be raised and lowered as the skier strides relative to the snow. The invention is more specifically related to an improvement in the ski and binding in terms of the modern-day equipment in which, rather than being in front of the boot, the attachment of the boot to the ski is situated beneath the boot, such as at the metatarsophalangeal bending zone of the foot. As explained in paragraph 0007 of Applicants’ specification, in spite of the advantages provided by the location of the attachment of the boot in such aforementioned modern-day equipment, a particular disadvantage is the necessity to provide, as part of the binding, a plate between the boot and the top surface of the ski, thereby effectively raising the boot relative to the ski. The invention, therefore, provides a ski and a ski system in which the skier’s boot is directly supported on the top surface of the ski despite it being attached to the ski *beneath* the boot. In this regard, see Fig. 4, e.g., in which the binding device 12 (shown schematically; Fig. 1 shows the binding device in greater detail) is situated within a recess 29 formed in the top of the ski, thereby exposing upper surfaces 28 to directly support the sole of the boot, as explained in paragraph 0016.

Exemplary independent claim 21 is copied below. For convenience, reference numerals are added for relating the claim terminology to the illustrated embodiments of the invention, although the scope of Applicants’ invention is not to be limited by such reference:

Claim 21. A cross-country ski system comprising:

- a cross-country ski (10) and a binding device (12) having a mechanism (16, 20) to engage a boot (14) to bind the boot to the ski;

- the cross-country ski having a longitudinally extending binding zone (29) spaced from front and rear ends of the ski, said binding zone comprising:

- a pair of transversely spaced apart longitudinally extending upper support surfaces (28) structured and arranged to support directly support surfaces of a sole of a boot at least in a metatarsophalangeal bending zone of the boot when the boot is engaged with a mechanism of the binding device for engagement with the boot;

- an upwardly open longitudinally extending recess (in zone 29 - see FIGS. 3, 4) positioned between said pair of upper support surfaces (28);

- at least in the binding zone (29), the ski has an upper surface width greater than a width of the binding device (see FIGS. 2, 4, 6), thereby exposing the upper support surfaces (28) for direct contact with the sole of the boot on opposite lateral sides of the binding device (12);

the binding device (12) being structured and arranged to be fixed upon the ski (10) in the recess (in zone 29; FIGS. 3, 4) of the binding zone, the binding device having an upwardly projecting rib (24) adapted to be positioned within a downwardly facing longitudinally groove in the sole of the boot (14).

Exemplary dependent claim 22 adds the following requirements to the subject matter recited in parent claim 21:

Claim 22. A cross-country ski system according to claim 21, wherein:

the cross-country ski system includes no baseplate that would prevent a lower external surface of the boot from direct supporting engagement on the upper support surfaces of the ski.

B. *Withdrawal of Rejection Based Upon GIGNOUX + BEJEAN*

Applicants request withdrawal of the §103(a) rejection based upon GIGNOUX and BEJEAN at least for the following reasons.

BEJEAN's invention is described as being adapted for a ski shoe "whose toe is attached to the ski" See, e.g., column 1, lines 48-49. This is the type of binding Applicants' invention is an improvement upon or, stated differently, Applicants' invention is an improvement for a type of binding which is described by Applicants in their paragraphs 0004-0006, which is a successor to the type of binding disclosed by BEJEAN, i.e., one in which the boot is articulated about an axis rearward of the front end of the sole (see Applicants' paragraph 0004). In fact, as Applicants explain in their paragraph 0007, it is a particular characteristic of the successor types of binding which raises the boot from the upper surface of the ski.

BEJEAN is so little interested in the binding itself, he fails to illustrate it. He simply points out (column 1, lines 48-49) that the toe of the ski shoe "is attached to the ski, consistent with a prevalent type of binding at the time. On the other hand, BEJEAN's invention is "an improved apparatus for a cross-country ski which imparts an elastic rebound to the shoe in response to a downward movement of the heel into engagement with the ski," as BEJEAN explains in column 1, lines 39-43. More specifically, "[a]s a result of its compression, rib 2 forms a spring which exerts an upwardly directed force F (FIG. 3) on the bottom 4a of groove 4 [of the underside of the boot sole 3]."

For the purpose of mounting his elastic rib 2, BEJEAN illustrates (in the embodiment of Fig. 4) a longitudinal groove 5c in the upper surface 5d of the lower portion 5a of the longitudinal guide rib 5 (see column 3, lines 29-46) which cooperates, during cross-country skiing, with the sole 3 of a ski boot whose sole 3 contains on its lower surface longitudinal groove 4 ..." (see column 2, lines 63-65).

BEJEAN's longitudinal groove 5c receives *not a binding device* but an "*elastomeric bar*" 5b, i.e., it receives the upper portion of the guide rib 5 (see column 3, lines 35-38).

As acknowledged on page 3, lines 9-10, of the Office action, "Gignoux et al. do not disclose a recess in the upper surface of the ski."

Applicants respectfully traverse the Examiner's conclusion that BEJEAN renders obvious to have provided a recess in GIGNOUX's ski to insert GIGNOUX's binding. The only purpose behind BEJEAN's recess in Fig. 7 is to present an elastic rebound member 2 to push the underside of the boot away from the ski. BEJEAN does not insert a binding into a recess. Further, GIGNOUX's binding is not an elastic rebound member. Still further, BEJEAN's plate 8 for the rebound member 2 prevents the boot from directly engaging the upper surface of the ski. The reasoning required for the rejection is that of improper hindsight.

Further, GIGNOUX says nothing about contact between the ski 9 and the boot 60 and, even if the combination of GIGNOUX and BEJEAN were plausible, the related limitation would not be met. The drawings show no specific engagement. Moreover, if the schematic depiction of the boot 60 shown in GIGNOUX's Fig. 6, i.e., by means of a photocopy of such boot, is overlaid upon Fig. 6, with the lowermost edge of the boot 60 horizontal, and pivot points 61 of the boots of Fig. 6 and the photocopy aligned, a space appears between lowermost edge of the boot and the upper surface of the ski. Still further, rearward of the "rear bar 62" in GIGNOUX's Fig. 1, Fig. 4, and Fig. 6 shows two closely positioned parallel lines atop what appears to be the upper surface of the ski. These lines would appear to be just as likely indicative of some type of boot support above the ski surface as it would be indicative of some sort of engagement, or a suggestion of engagement.

Of course, because GIGNOUX provides no textual description of engagement of the boot and the ski, any conclusion regarding same amounts to speculation and surmise. Further in this regard, the Manual of Patent Examining Procedure (MPEP), (Rev. 5, Aug. 2005) provides the following guidance regarding arguments such as that advanced in support of the rejection of Applicants' claims based upon what GIGNOUX might have disclosed:

When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000).

Still further, Applicants respectfully traverse the Examiner's comment in lines 3-6 on page 7 of the Office action, that "Applicant has provided no evidence ..." The burden is on the Examiner, not the Applicant, in supporting a rejection for obviousness.

Applicants respectfully submit that, for the reasons given above, a convincing line of reasoning as to why the artisan would have found their invention to have been obvious has not been provided by BEJEAN and GIGNOUX. Accordingly, reconsideration and withdrawal of the rejection is kindly requested.

C. *Withdrawal of Rejection Based at Least Upon BEJEAN + GIGNOUX + KENNEY*

Applicants request withdrawal of the §103(a) rejection of claim 16 based upon the combination of BEJEAN, GIGNOUX, and KENNEY for the reasons of record. See Applicants' remarks beginning near the bottom of page 15 of their reply filed on February 12, 2010.

D. *Withdrawal of Rejection for Non-Compliance with the Written Description Requirement*

Applicants request withdrawal of the rejection of claims 29, 32, 34, 37, and 39 for failing to comply with the written description requirement of 35 USC §112, first paragraph, the basis for the Examiner's rejection being that "[t]he specification does not explicitly disclose a ski lacking a boot sole-engaging rib."

First, a literal description in the original application for a claim limitation is not necessary for compliance with the written description requirement of §112, first paragraph. See, e.g., MPEP §2163.02.

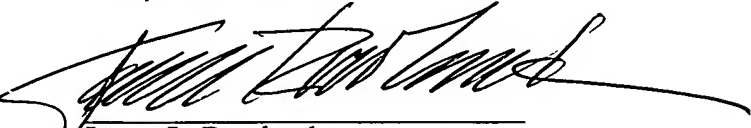
Second, Applicants' Fig. 3 illustrates in perspective a ski according to the invention, lacking a boot-sole engaging rib, thereby providing support for the aforementioned limitation.

Third, claims 34 and 39 do not include the aforementioned limitation, nor the subject matter thereof.

E. *Summary and Conclusion*

At least for reasons given above, withdrawal of the grounds of rejection is kindly requested. In addition, Applicants kindly invite the Examiner to contact their undersigned representative in the event the Examiner had any question or for the purpose of expediting resolution of issues.

Respectfully submitted,
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